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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL J. SUNDERMEYER and NARCISO B. JARAMILLO

Appeal 2008-005736
Application 10/690,214
Technology Center 2100

Decided: September 4, 2009

Before JAMES D. THOMAS, JAY P. LUCAS,
and STEPHEN C. SIU, *Administrative Patent Judges*.
THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL
STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-31. We have jurisdiction under 35 U.S.C. § 6(b).

We vacate the rejections before us under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(b), and we institute new grounds of rejection within the provisions of 37 C.F.R. 41.50(b).

INVENTION

The present invention maintains a Web site that includes browsing to a Web page to be edited, automatically downloading a source file for the Web page including related files associated with display of the Web page, editing the source file, and automatically publishing the edited source file to a file transfer server associated with the Web site including the related files associated with the display of the Web page. (Spec. 21, Abst.)

ILLUSTRATIVE CLAIM

Below is reproduced independent claim 21:

21. A Web page editor comprising:

a graphical interface (GI) for receiving interaction from a user;

a Web browser displayed to said user in a main window of said GI;

an edit indicator, associated with said display of said Web browser, presented to said user on said GI, wherein said edit indicator controls execution of retrieval logic;

an edit screen replacing said Web browser in said main window responsive to said user selecting said edit indicator, wherein said user makes edits to said Web page; and

a publish indicator, associated with a display of said edit screen, presented to said user on said GI, wherein said publish indicator controls execution of said upload logic.

PRIOR ART AND EXAMINER'S REJECTIONS

The Examiner relies on the following references as evidence of anticipation and unpatentability:

GlobalScape, *CuteFTP Pro Technical Overview*, White Paper, (2001), published on the internet at least by August 14, 2002, last downloaded by the Examiner on March 17, 2006, available at http://lweb.archive.org/lweb/1200208141335091www.globalscape.com/support/manu_als.shtml, pages i-ii and 1-17, [hereinafter *CuteFTP*].

Altova Inc. & Altova GmbH, *XML Spy 4.0 Manual*, copyright 1998-2001, September 10, 2001, Chapter 3, consisting of pages 91-286, [hereinafter *XML Spy*].

Claims 1-19 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Cute FTP. Claims 20-31 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness as to claim 20, the Examiner relies upon XML Spy alone, with the edition of Cute FTP for claims 21-31.

FINDINGS OF FACT (FF)

1. Appellants' assessment of the prior art in the background portion of the Specification as filed states:

Web sites and Web pages typically comprise a Web server, that serves the visual and data content to the user's browser many times in a format, such as hypertext markup language (HTML), and a file transfer server, that provides read and write-access to the files that servers are usually conceptualized as separate and independent machines, they, in fact, are typically software applications, which often time run on the same computer. The underlying Web files are

usually stored on that computer or a storage device accessible by that computer, while the Web server and file transfer server interact with those files in different ways. Web servers typically allow read-only access to the files through HTML browsers, compared to the read/write-access usually allowed by the file transfer servers.

[Para. 0004].

2. The initial line of paragraph [0022] characterizes the present invention as a “browse-edit paradigm.”

ANALYSIS

We vacate the rejections under 35 U.S.C. § 102(b) and 35 U.S.C. § 103 because we conclude that claims 1-31 are “barred at the threshold by § 101.” *In re Comiskey*, 554 F.3d 967, 973 (citing *Diamond v. Diehr*, 450 U.S. 175, 188)(1981). Therefore, the following new grounds of rejection are set forth in this opinion within the provisions of 37 C.F.R. 41.50(b).

New Rejection under 35 U.S.C. § 101

Statutory subject matter comprises a machine, a manufacture, a process, or a composition of matter as permitted within 35 U.S.C. § 101. Moreover, our reviewing court has stated that “[t]he four categories [of § 101] together describe the exclusive reach of patentable subject matter. If the claim covers material not found in any of the four statutory categories, that claims falls outside the plainly expressed scope of § 101 even if the subject matter is otherwise new and useful.” *In re Nuijten*, 500 F.3d 1346,

1354 (Fed. Cir. 2007), *reh'g en banc denied*, 515 F.3d 1361 (Fed. Cir. 2008), *cert. denied*, __ U.S.__, 127 S. Ct. 70 (2008). *Accord In re Ferguson*, 2009 WL 565074, (Fed Cir.2009). This latter case held that claims directed to a “paradigm” are non-statutory under 35 U.S.C. § 101 as representing an abstract idea.

With this background in mind, claims 1 through 31 are rejected under 35 U.S.C. § 101.

As noted in finding of fact 2, Appellants characterize their invention as a “browse-edit paradigm” which is consistent with the proscription noted *In re Ferguson*. As such, the direct claiming of a “Web page editor” of independent claim 21 on appeal recites subject matter that is considered not to be statutory within 35 U.S.C. § 101. Such an editor is also not one of the permitted statutory categories of invention within Section 101.

To the extent any independent claim 1, 11, 20, and 21 on appeal recites or otherwise makes reference to a web browser or file transfer server or web server, finding of fact 1 plainly indicates that the art considers these to be software applications themselves. Therefore, each independent claim on appeal either directly or indirectly recites software per se, which has not been indicated in the case law we cited earlier in this opinion to be statutory subject matter as recited. Some of these independent claims directly require human steps or manipulations which are also proscribed. The claimed graphical user interface (GUI) in the preamble of independent claim 20 directly relates to non-tangible, labeled, information/images which are

inclusive of excluded abstract intellectual ideas or concepts. The same may be said of the graphical interface (GI) of independent claim 21 on appeal as well as its apparent inclusion as a software entity per se. Independent claim 21 further recites directly indicators and screens as well. These all relate to data structures which are merely information abstractions.

For method independent claims 1 and 20 on appeal, there is no recitation of a machine or a transformation of an article in accordance with *In re Bilski*, 545 F.3d 943, 959-60 (Fed. Cir. 2008) (en banc). The Supreme Court's "machine-or-transformation test, properly applied, is the governing test for determining patent eligibility of a process under § 101." *Id.* at 956. "A claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing." *Id.* at 954. The features of automatically downloading and automatically publishing relate to human initiated actions that are performed by the above-noted software applications from our excerpt of Appellants' background of the invention statement in finding of fact 1. Additionally, the "Web page editor" of independent claim 21 is also not recited as a machine. It is a software entity, a "browse-edit paradigm." The recited source files of independent claim 1 are not considered to be articles or tangible articles but merely abstractions of data per se.

As to independent claim 11 on appeal, the claimed computer program product appears to indirectly recite Appellants' "browse-edit paradigm" concept we noted in finding of fact 2 and is directly recited in the body of

this claim to “comprise” various “code for” performing certain functionalities. As such, Appellants are directly claiming the computer program code for performing the recited functions. Software code is an idea without physical embodiment; it is intangible. The preamble of independent claim 11 directly relates to a computer program logic that ambiguously appears to relate to the “code” recited in the body of this claim. The computer readable medium of the preamble does not recite that the medium is a tangible medium.

New Rejection under the Enablement provision of 35 U.S.C. § 112, first paragraph

As to the enablement issue, the specification of the patent must teach those skilled in the art how to make and use the claimed invention without undue experimentation. *Genentech, Inc. v. Novo Nordisk A/S*, 108 F.3d 1361, 1365 (Fed. Cir.), cert. denied, 118 S.Ct. 397 (1997). This same case indicates that the scope of the claims must bear a reasonable correlation to the scope of enablement provided by the disclosure. Enablement is also not precluded even if some experimentation is necessary, although the amount of experi-mentation needed must not be unduly excessive. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987).

With this background, claims 1 through 31 are rejected under 35 U.S.C. § 112, first paragraph, enablement provision.

Appellants' disclosed invention is based upon a functional description of desired results and, indeed, may be fairly characterized as a concept invention. The various portions of Figure 1 are characterized as screen shots that are derived from underlying software components that are directly recited in independent claim 11 on appeal, for example, and directly recited in independent claims 20 and 21 as well, but which are based upon non-disclosed computer code. As noted earlier, independent claim 11 directly recites the code itself and independent claim 1 indirectly recites the functionality/results of it. Significantly, there is no computer code disclosed at all on which to base the claimed "computer program product" of claim 11 as well as the functionalities recited in the other claims. The claimed "code" of claim 11 cannot be derived from the broad concepts set forth in flowchart Figure 3 without undue experimentation.

The mere incorporation by reference of the three related applications noted at the top of Specification page 1 in paragraph [0001] is of no help since they are not specifically taught here to detail the disclosed basis or the functionality broadly recited in the independent claims on appeal. The disclosures of them have not been specifically integrated with what is disclosed in this application but have been merely passively mentioned. Essentially, Appellants have said to the person of ordinary skill in the art, go figure out yourself how to make and use the claimed invention rather than specifically teach the artisan how to make and use the claimed invention.

New Rejection under the second paragraph of 35 U.S.C. § 112

Claims 1-31 are rejected under the second paragraph of 35 U.S.C. § 112 as being indefinite.

Beginning with independent claim 11, substantial ambiguity exists as to whether the claimed computer program product is embodied on a tangible medium. The computer program product appears to be ambiguously recited in the body of the claimed as computer code as well as computer program logic. Ambiguities exist as to which whether this computer program logic is the code itself or some additional functionality. There is no clear manner in which to determine the scope of meaning to be attributed to the computer readable medium and the computer program product recitations. Because the claimed functionalities among all claims on appeal lack a sufficient description of the disclosed basis underlying them, all claims are considered to be indefinite as well.

SUMMARY AND DECISION

Because claims 1-31 fail at the outset to meet subject matter requirements within 35 U.S.C. § 101, we have vacated the outstanding rejections under 35 U.S.C. § 102(b) and 35 U.S.C. § 103. On the other hand, within the provisions of 37 C.F.R. 41.50(b), we have instituted three new grounds of rejection of claims 1-31. These include a rejection under 35 U.S.C. § 101, a separate rejection under the enablement provision of

35 U.S.C. § 112, first paragraph, as well as a separate rejection under the second paragraph of 35 U.S.C. § 112.

In addition to vacating the Examiner's rejection(s) of one or more claims, this decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides that "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

VACATED

37 C.F.R. § 41.50(b)

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